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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/350,858 07/09/99 CHU

M 97-2166

EXAMINER

MCGUTHRY BANKS, T

ART UNIT

PAPER NUMBER

1742

DATE MAILED:

03/15/01

IM52/0315  
DAVID W PEARCE-SMITH ESQ  
ALUMINUM COMPANY OF AMERICA  
ALCOA TECHNICAL CENTER  
100 TECHNICAL DRIVE  
ALCOA CENTER PA 15069-0001

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

**Office Action Summary**

Application No.

09/350,858

Applicant(s)

CHU ET AL.

Examiner

Tima M. McGuthry-Banks

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 March 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 18-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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## DETAILED ACTION

### *Response to Arguments*

1. Applicant's request for reconsideration has been fully considered but is not persuasive. Applicants state that Nagle does not teach using carbides of Sc, V, Mo, or Nb. However, Nagle does teach such a limitation in column 8, lines 58-67.

### *Claim Objections*

2. Claim 24 is objected to because of the following informalities: the claim is identical to Claim 22. Claim 24 must either be cancelled or amended to be distinguishable from Claim 22. Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 18, 20, and 21-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Nagle et al (US 4,915,908).

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Nagle anticipates the claimed invention. Nagle teaches a method for the production of a composite comprising a distribution of second phase particles in a metal, metal alloy, or intermetallic final matrix. The method comprises the following steps:

- a) preparing a mixture of elemental powders and a substantially nonreactive solvent metal,
- b) adding the mixture to a molten metal matrix, metal alloy, or intermetallic, and
- c) forming the composite by the diffusion and reaction of the mixture (Claim 1).

The solvent metal and the molten matrix metal comprise aluminum or alloys of aluminum (Claim 8). The particulate second phase includes zirconium carbide (Claim 16). Example 5 in column 7 demonstrates the ability to disperse titanium carbide second phase particles throughout an aluminum final matrix. Nagle also teaches that the particle size is from less than about 0.01 to about 0.5 microns (column 13, lines 63 and 64). Examples of the second phase ceramic precipitates are carbides and include molybdenum, niobium, vanadium, and scandium (column 8, lines 58-62).

***Claim Rejections - 35 USC § 102/103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claim 19 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nagle.

Nagle teaches the invention substantially as claimed. Though Nagle teaches that the particle size is from less than about 0.01 to about 0.5 microns (column 13, lines 63 and 64), Nagle does not disclose the step of providing a chloride salt as claimed. Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. *In re Best*, 195 USPQ 430, 433 (CCPA 1977). Applicants state on page 9, lines 5-7 that the salt is decanted or removed after the reaction occurs to produce the carbide particles. Therefore, the final product taught in Nagle reads on the claimed product.

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

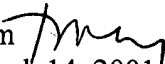
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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tima M. McGuthry-Banks, whose telephone number is 703-308-1917. The examiner can normally be reached on 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King, can be reached on 703-308-1146. The fax numbers for the organization where this application or proceeding is assigned are 703-305-3599 for regular communications and 703-305-7719 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist, whose telephone number is 703-308-0651.

tmm   
March 14, 2001

ROY KING   
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700